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PTO/SB/SS (07-05)

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)  
03179524

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Signature

Typed or printed

name Adam DominguezApplication Number  
09/641,095Filed  
08/17/2000First Named Inventor  
Donald B. BensonArt Unit  
3639Examiner  
Robinson Boyce, Akiba K

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 39,777☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

Michael A. Molano

Typed or printed name

650 331-2000

Telephone number

April 11, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☐

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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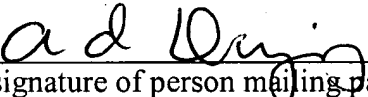


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Donald B. Benson ) ATTORNEY 03179524  
SERIAL NO.: 09/641,095 ) DOCKET:  
FILED: August 17, 2000 ) GROUP ART UNIT: 3639  
TITLE: SYSTEM AND METHOD FOR COMBINED MAILING OF A PLURALITY  
OF DIVERSE PUBLICATIONS (AS AMENDED)

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Alexandria, VA 22313-1450

**ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir/Madam:

The Applicant submits this Attachment to the Pre-Appeal Brief Request For Review  
pursuant to the *New Pre-Appeal Brief Conference Pilot Program*, 1296 Off. Gaz. Pat. Office 67  
(July 12, 2005)(as extended by the *Extension of the Pilot Pre-Appeal Brief Conference Program*  
dated January 10, 2006).

## **I. Summary Of Clear Error Of Facts In Examiner's Rejection**

To maintain an obviousness rejection, the Examiner states in a final rejection that “the Applicant has not disclosed that installing the print head at the co-mailer rather than at the bindery provides an advantage, is used for a particular purpose, or solves a stated problem, and the applicant’s argument is therefore moot.” 3/13/06 Final Office Action, p. 7. This statement is a clear error of the facts in this application since the Applicant specifically provided nearly two full pages of explanation and at least four citations to the specification as filed in the prior Response to provide evidence of the “advantage, ...particular purpose, or...[solved] problem” of having a “print head” at a particular location (co-mailer) in the system of the present invention. 12/8/05 Response, pp. 17-19. The Examiner apparently overlooked that evidence that rebutted the obviousness determination that would have resulted in allowance of independent claims 9, 18 and 28. The Applicant respectfully requests that this evidence be considered and that independent claims 9, 18 and 28 be allowed after reconsideration, as well as those claims depending on claims 9, 18 and 28.

## **II. Present Application**

This application discloses a combined mailing (“co-mailing”) system that includes a bindery and a co-mailer. Unlike prior co-mailing systems, the claimed invention calls for having a “first print head” and a “second print head” at the co-mailer of the system which has distinct advantages as described in the Applicant’s 12/8/05 Response:

In contrast, the embodiment of the present invention claims ‘print head(s)’ at the co-mailer. By having the print head(s) at the co-mailer, the co-mailing system of the present invention has greater flexibility than the Mayer Reference to select the publications for co-mailing after binding. The co-mailer of the present invention prints the mail rate after the bindery at the co-mailer based on the total number of copies of the publications per zip code (or other ‘identifier information’) for all the publications to be co-mailed and as required by the USPS. This is unlike the Mayer Reference

that only prints address information at the bindery. The advantage is greater flexibility by printing the mail rate at the co-mailer versus the bindery since publications can be added at the co-mailer from other bindery runs and conforming to USPS requirements.

12/8/05 Response, pp. 17-18. *See also*, 12/8/05 Response, pp. 18-19, four bullet points.

### **III. The Examiner Committed Clear Error By Overlooking The Advantages Explained In The Applicant's Prior Response To Rebut The Obviousness Determination**

In an August 11, 2005 Office Action, the Examiner admitted that the claimed "print head" of the present invention (located at a co-mailer rather than a bindery) was not disclosed in the primary reference cited (Mayer et al.). August 11, 2005 Office Action, p. 3. However, the Examiner found that the claimed "print head[s]" would have been obvious because a printer was disclosed at the bindery in Mayer et al. and the Applicant has "not disclosed that installing the print head at the co-mailer rather than at the bindery provides an advantage, is used for a particular purpose, or solves a stated problem." *Id.*

In a December 8, 2005 Response, the Applicant specifically explained the importance of the location of the print head(s) and provided four instances quoted directly from the specification as filed that explained the "advantage, ...particular purpose, or...[solved] problem" that result from having the "print head[s]" at the co-mailer rather than at the bindery. December 8, 2005 Response, pp. 17-19.

In a Final Office Action dated March 13, 2006, the Examiner overlooked the four instances provided by the Applicant supporting the "advantage, ...particular purpose, or...[solved] problem," and merely stated once again that "the Applicant has not disclosed that installing the print head at the co-mailer rather than at the bindery provides an advantage, is used for a particular purpose, or solves a stated problem, and the applicant's argument is therefore moot." March 13, 2006 Final Office Action, p. 11.

The clear error is that the “advantage, ...particular purpose, or...[solved] problem” set forth in the December 8, 2005 Response, on pages 17-19, was overlooked by the Examiner. The fact that the Examiner affirmatively states that the “Applicant has not disclosed” these advantages when nearly two pages in the prior Response are devoted to the advantages shows that the Examiner erroneously missed those advantages. Had the Examiner noted the specific advantages provided, the Examiner would have appropriately allowed these claims over the Mayer et al. reference.

#### **IV. Conclusion**

The Applicant respectfully requests that the evidence of “advantage, ...particular purpose, or...[solved] problem” set forth in the Applicant’s December 8, 2005 Response be considered to rebut the obviousness rejection of claims 9, 18 and 28. Upon reconsideration, allowance of those claims, and those claims depend on claims 9, 18 and 28, is respectfully requested.

Respectfully submitted,



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Reg. No. 39,777

Dated: April 11, 2006

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